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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,174	12/05/2001	William Gobush	20002.0162	3740

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EXAMINER

NGUYEN, KIM T

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,174

Applicant(s)

GOBUSH ET AL.

Examiner

Kim Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 & 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5 and 14 of copending Application No. 09/782,278 (hereinafter '278). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 18 and 28 of the present

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application basically teach the same inventive subject matter of claims 1 and 5 of the application '278 except that claims 1, 18 and 28 broaden the scope of claims 1 and 5 of the application '278 by replacing the camera with a light receiver. Further, other dependent claims of the present application such as choosing a specific primary emission wavelength, a specific low pass filter wavelength, etc. would have been obvious to a person of ordinary skill in the art at the time the invention was made.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gobush et al (US. 5,575,719) in view of McSheery et al (US. 6,324,296).

a. As per claim 1, Gobush discloses a portable monitor system comprising a light source (col. 3, lines 33-35), a light receiver (col. 2, lines 62-64), the object has a fluorescent marker (col. 3, lines 3-18). Gobush does not explicitly disclose including a filter into the light receiver.

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However, McSheery suggests implementing a filter to the light receiver (col. 11, lines 63-65). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the filter of McSheery to the light receiver of Gobush in order to allow recording light waves at an interested wavelength.

- b. As per claim 2, selecting a specific emission wavelength to observe requires only routine skill in the art.
- c. As per claim 3, Gobush discloses using a lowpass filter (col. 12, lines 3-9).
- d. As per claim 4-6 and 10, selecting a filter with a suitable cut off wavelength, a light source with a specific emission spectrum center wavelength, permitting a light with a specific frequency to pass the filter requires only routine skill in the art.
- e. As per claim 7-8, McSheery discloses a bandpass filter (col. 11, lines 63-65). Further, selecting a bandpass filter having a specific center wavelength as required requires only routine skill in the art.
- f. As per claim 9, the electronically switchable filter is a well known filter type.
- g. As per claim 11-12, Gobush discloses a strobe light source (col. 5, lines 15-18). Further, using light emitting diode as a light source would have been well known to a person of ordinary skill in the art at the time the invention was made.
- h. As per claim 13, Gobush discloses including another object having a marker (col. 5, lines 10-13). Gobush does not disclose using marker of different reflective wavelength, size, etc. for the other object. However, it would have been obvious to a person of ordinary skill in the art at

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the time the invention was made to select a specific marker with specific reflective wavelength, size, etc. in order to facilitate tracking a specific object and excluding the object that the user is not interested in tracking the object.

- i. As per claim 14, Gobush discloses a golf ball object (col. 3, lines 15-18).
- j. As per claim 15, using an orange-fluorescent marker would have been well known to a person of ordinary skill in the art at the time the invention was made.
- k. As per claim 16-17, Gobush discloses including a central processing unit 5 in the system (Fig. 4). Further, designing a system with a specific weight to fit a specific application requires only routine skill in the art. Further, using a battery as a power source would have been well known to a person of ordinary skill in the art at the time the invention was made.
- l. As per claim 18-35, refer to discussion in claims 1, 3-4, 6-11, and 13 above.

Cited References

- 5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kuwashima et al (US. 5,764,786) and ***Morander*** (US 2003/0146972) disclose monitoring system.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (703) 308-7915. The examiner can normally be reached on Monday-Thursday from 8:00AM to 5:00PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg, can be reached on (703) 308-1327. The central official fax number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

kn

Date: November 26, 2006


KIM NGUYEN
PRIMARY EXAMINER